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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,877	05/01/2001	Toshio Iwai	397.35.01	5007
22242	7590	10/06/2005	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/846,877	Applicant(s) IWAI ET AL.	
	Examiner Thai Tran	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/12/03 &amp; 10/24/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 because claims 1-13 are directed to a recording medium for storing a program and data for use of an entertainment system and claim 14 is directed to a program for use of an entertainment system.

Data structures not claimed as embodied in computer-readable medium are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-8, 13-22, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuichiro et al (JP 10328414 A and submitted by applicants).

Regarding claim 1, Yuichiro et al discloses a recording medium (element 8 of Fig. 1) for storing a program and data for use of an entertainment system, said entertainment system comprising:

an entertainment apparatus (CPU 3 of Fig. 1, the abstract) for executing various programs;

at least one input device (an handwriting inputting device 2 of Fig. 1, the abstract) for inputting a manual control request of a user to said entertainment apparatus; and

a monitor (a display 1 of Fig. 1, the abstract) for displaying an image outputted from said entertainment apparatus;

wherein said program comprises the step of:

selecting a symbolic image from a plurality of symbolic images available for a scene currently displayed on the monitor based on an input geometric shape indicated by an input pattern image drawn according to data inputted by the user with said input device (the abstract and Figs. 8-9); and

displaying said selected symbolic image on said monitor (the abstract and Figs. 8-9).

Regarding claim 2, Yuichiro et al also discloses the claimed wherein said program further comprises the step of controlling the progress of a scenario in the scene currently displayed on said monitor based on said symbolic image (the abstract and Figs. 8-9).

Regarding claim 3, Yuichiro et al discloses the claimed wherein said step of selecting a symbolic image comprises the steps of:

converting said data inputted by the user with said input device into an input pattern image (the abstract and Figs. 8-9); and

judging an input geometric shape indicated by said input pattern image based on a plurality of judging criterion (the abstract and Figs. 8-9).

Regarding claim 4, Yuichiro et al also discloses the claimed wherein said program further comprises the step of determining a form of said selected symbolic image based on accuracy of said input geometric shape (the abstract and Figs. 8-9).

Regarding claim 5, Yuichiro et al discloses the claimed wherein said step of determining a form of said selected symbolic image comprises the steps of:

Determining accuracy of said input geometric shape based on a judging criteria used in said step of judging an input geometric shape by calculating the number of deviations from an allowable range of said judging criteria (the abstract and Figs. 8-9); and

Modifying a form of said selected symbolic image displayed on said monitor based on accuracy of said input geometric shape (the abstract and Figs. 8-9).

Regarding claim 6, Yuichiro et al discloses the claimed wherein said input geometric shape comprises a segment having a starting point and an ending point, and a judgment as to whether said input geometric shape is a straight line or not is performed in said step of judging an input geometric shape by determining whether said

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ending point is within an allowable area or not, said allowable area extending from said starting point and having an acceptable deviation width (the abstract and Figs. 8-9).

Regarding claim 7, Yuichiro et al discloses the claimed wherein said input geometric shape comprises a segment having a starting point and an ending point, and a judgment as to whether said input geometric shape is a straight line or not is performed in said step of judging an input geometric shape by determining whether said segment is within an allowable area having an acceptable aberration width or not (the abstract and Figs. 8-9).

Regarding claim 8, Yuichiro et al discloses the claimed wherein said input geometric shape comprises a segment having a starting point and an ending point, and a judgment as to whether said input geometric shape is a circle or not is performed in said step of judging an input geometric shape by determining:

whether said starting point and said ending point are closely positioned or not (the abstract and Figs. 8-9);

whether the difference in length between sides of an imaginary rectangle circumscribing said input geometric shape is within an allowable range or not (the abstract and Figs. 8-9);

whether there is a corner in said geometric shape or not (the abstract and Figs. 8-9); and

whether there is a crossing positioned remotely from said starting point and said ending point or not (the abstract and Figs. 8-9).

Regarding claim 13, Yuichiro et al discloses the claimed wherein said program further comprises the step of setting waves of a basis image displayed on said monitor according to said input geometric shape such that said basis image waves arbitrarily (the abstract and Figs. 8-9).

The program of claim 14 is rejected for the same reasons as discussed in a recording medium of claim 1.

System claims 15-22 are rejected for the same reasons as discussed in the recording medium claims 1-8.

System claim 27 is rejected for the same reason as discussed in the recording medium claim 13.

Apparatus claim 28 is rejected for the same reasons as discussed in the recording medium claim 1.

Method claim 29 is rejected for the same reasons as discussed in the recording medium claim 1.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9-12 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuichiro et al (JP 10328414 A and submitted by applicants) in view of Padwa (WO 98/321107).

Regarding claim 9, Yuichiro et al discloses all the claimed limitations as discussed in claim 1 above except for providing wherein said program further comprises the step of displaying an animation of said symbolic image on said monitor such that said symbolic image moves arbitrarily in accordance with background music.

Padwa teaches, in an apparatus for teaching drawing, penmanship, and hand-eye-memory coordination, a soundback feature which provides an audible cue as to the accuracy of the entry and based on the trace figure (page 16, lines 15-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the soundback feature as taught by Padwa into Yuichiro et al's system in order to allow the user to rely on changes in the audible magnitude or pitch to guide him in the entry of the trace figure (page 16, lines 15-34).

Regarding claim 10, Padwa also discloses the claimed wherein said program further comprises the step of setting sounds such that the sounds are outputted synchronously with the movement of said symbolic image (page 16, lines 15-34).



Regarding claim 11, Padwa also discloses the claimed wherein said step of setting sounds comprises the step of setting tones of sounds based on at least the size of said symbolic image displayed on said monitor (page 16, lines 15-34).

Regarding claim 12, Padwa also discloses the claimed wherein said step of setting sounds comprises the step of setting pitches of sounds based on at least the position of said symbolic image displayed on said monitor (page 16, lines 15-34).

System claims 23-26 are rejected for the same reasons as discussed in recording medium claims 9-12 above.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to video game.

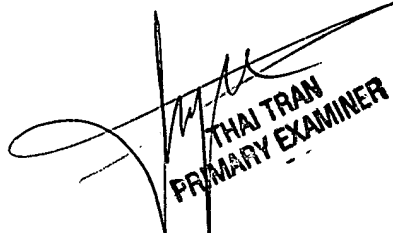
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN  
PRIMARY EXAMINER